

REMARKS

This Application has been carefully reviewed in light of the Office Action mailed September 14, 2004. Applicant appreciates the Examiner's consideration of the Application. In order to advance prosecution of this Application, Applicant has responded to each notation by the Examiner. Applicant respectfully requests reconsideration and favorable action in this case.

Response to Restriction Requirement

Applicant elects Claims 1-22 for prosecution on the merits, and withdraws Claims 23-185 without prejudice or disclaimer for prosecution in a divisional application.

Non-Statutory Double Patenting Rejection

The Examiner rejects Claims 1 and 2 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 and 2, respectively, of U.S. Patent No. 6,167,391. Although Applicant does not necessarily agree with or acquiesce to the Examiner's comments regarding the claims of the present Application or their purported relationship to the claims of U.S. Patent No. 6, 167,391, Applicant submits the attached Terminal Disclaimer to obviate these rejections. Applicant respectfully requests reconsideration and allowance of Claims 1 and 2.

Section 101 Rejection

The Examiner rejects Claims 1-22 under 35 U.S.C. § 101 as being directed towards non-statutory subject matter. Applicant respectfully disagrees.

Applicant respectfully submits that Claims 1-22 are directed towards statutory subject matter. When a computer program is recited in conjunction with a physical structure, such as a computer memory, Office personnel should treat the claim as a product claim. M.P.E.P. § 2106.IV.B.1(a). If a claim defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination, it defines a statutory product. M.P.E.P. § 2106.IV.B.2(a) (citing, *e.g.*, *Lowry, In re*, 32 F.3d 1579, 1583, 32 USPQ2d 1031, 1034-35 (Fed. Cir. 1994); *Warmerdam, In re*, 33 F.3d 1354, 1361-62, 31 USPQ2d 1754, 1760 (Fed. Cir. 1994)).

As an example, Claim 1 recites a “memory” and a “processor.” Claim 1 defines a useful machine or manufacture by identifying the physical structure of the machine or manufacture in terms of its hardware or hardware and software combination. Accordingly, Claim 1 defines a statutory product, and thus is allowable under 35 U.S.C. § 101.

Dependent Claims 2-22 are allowable based on their dependence on independent Claim 1. Because Applicant believes he has amply demonstrated the allowability of independent Claim 1 under 35 U.S.C. § 101, and to avoid burdening the record, Applicant has not provided detailed remarks concerning these dependent claims. Applicant, however, remains ready to provide such remarks if it becomes appropriate to do so.

Applicant's Summary of Interview

In Response to the Interview Summary mailed September 14, 2004, Applicant respectfully submits Applicant's Summary of Interview pursuant to M.P.E.P. § 713.04. In the telephone interview, Applicant elected Claims 1-22 for prosecution and restricted Claims 23-185. No agreement, however, was reached on whether Claims 23-185 are distinct, or on whether each independent claim of Claims 23-185 requires separate searches.

CONCLUSION

Applicant has made an earnest attempt to place this case in condition for allowance. For at least the foregoing reasons, Applicant respectfully requests full allowance of all the pending claims.

If the Examiner believes a telephone conference would advance prosecution of this case in any way, the Examiner is invited to contact Keiko Ichiye, the Attorney for Applicant, at the Examiner's convenience at (214) 953-6494.

Although Applicant believes no fees are due, the Commissioner is hereby authorized to charge any fees or credit any overpayments to Deposit Account No. 02-0384 of Baker Botts L.L.P.

Respectfully submitted,

BAKER BOTTS L.L.P.
Attorneys for Applicant



Keiko Ichiye
Reg. No. 45,460

KI/lis

Correspondence Address:

Baker Botts L.L.P.
2001 Ross Avenue, Suite 600
Dallas, Texas 75201-2980
(214) 953-6494

Date: 12/14/04

Customer Number: 05073